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PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Srdjan Kordic, et al.
Serial No.: 10/651,492
Filed: August 29, 2003
For: PROCESS FOR FABRICATING AN ELECTRICAL
CIRCUIT COMPRISING A POLISHING STEP
Group No.: 2812
Examiner: Scott B. Geyer

MAIL STOP AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Restriction Requirement dated January 26, 2005, the Applicants respectfully request a one (1) month extension of time.

The Applicants provisionally elect the claims of "Species 1" (Claims 1, 2, 4, 5, 7, 14-18, 21, 22, 24, and 30-32), WITH TRAVERSE.

The Restriction Requirement characterizes the claims as being directed to three "patentably distinct species." In particular, the Restriction Requirement asserts that Figures 1A-1F of the

Applicants' specification disclose a "first embodiment," Figures 2B-2C of the Applicants' specification disclose a "second embodiment," and Figures 4A-4F of the Applicants' specification disclose a "third embodiment." (*Restriction Requirement, Page 2, First paragraph*).

A Restriction Requirement must provide the particular factual basis for asserting that restriction is necessary. In particular, the "particular reasons ... for holding that the inventions as claimed are either independent or distinct should be concisely stated." (*MPEP § 816*). A "mere statement of conclusion" is inadequate. (*MPEP § 816*). Moreover, in making a restriction, it is the "claimed subject matter that is considered," and the claimed subject matter "must be compared in order to determine the question of distinctness or independence." (*MPEP § 806.01*).

First, the Restriction Requirement contains absolutely no analysis of the "claimed subject matter." The Restriction Requirement instead focuses on the drawings and asserts that the drawings disclose multiple embodiments. This is clearly improper because it is the claimed subject matter, not the drawings, that must be analyzed when making a restriction.

Second, the Restriction Requirement contains absolutely no "particular reasons" for holding that the claimed inventions are distinct. Rather, the Restriction Requirement simply makes the assertion that different drawings illustrate different embodiments and that these embodiments are patentably distinct species. These statements have no factual support in the Restriction Requirement. For example, the Restriction Requirement fails to explain how or why these different embodiments are patentably distinct. Instead, these statements represent a "mere statement of conclusion," which is inadequate when making a restriction.

Third, the Restriction Requirement incorrectly asserts that there is no “generic claim” pending in this application. Claims 1 and 17 are both generic claims for the various “embodiments” illustrated in the Applicants’ drawings.

Figures 1A-1F illustrate how a circuit is formed by fabricating multiple tracks 20 and a component 10. (*Application, Page 15, Lines 1-36*). Part of the formation involves forming inserts 12 and then removing inserts 12 (such as by polishing). (*Application, Page 13, Line 31 – Page 14, Line 29*). Figures 2B-2C illustrate how the same technique may be used to form a circuit having multiple sets of tracks 20, 20A, 20B. (*Application, Page 17, Line 35 – Page 18, Line 39*). Figures 4A-4F illustrate how a circuit is formed, where part of the formation involves forming inserts 12 and then removing inserts 12 by etching. (*Application, Page 22, Line 29 – Page 23, Line 8*).

Claims 1 and 17 claim all three of these “embodiments” shown in the Applicants’ drawings. For example, Claims 1 and 17 recite that a “first conducting material” is removed from a “first portion” of a circuit. Figures 1A-1F and 2B-2C illustrate the removal as a polishing step, while Figures 4A-4F illustrate the removal as an etching step. As another example, Claims 1 and 17 recite that a “second conducting material” is partially removed until part of a “second insulating material” in the first portion of the circuit is exposed. Again, Figures 1A-1F and 2B-2C illustrate the removal as a polishing step, while Figures 4A-4F illustrate the removal as an etching step. Claims 1 and 17 do not require any particular technique to remove the “first conducting material” or partially remove the “second conducting material.” Rather, the specific techniques for the removal of the conducting materials are recited in the dependent claims. As a result, Claims 1 and 17 are generic claims

claiming all three “embodiments” shown in Figures 1A-1F, 2B-2C, and 4A-4F of the Applicants’ specification.

With respect to the alleged distinctness of the Species 1 claims from the Species 2 and Species 3 claims, the Restriction Requirement fails to satisfy the requirements for restricting the claims of this patent application. Accordingly, the Applicants respectfully request that the restriction be withdrawn.